



11-19-07

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Patent
Attorney Docket No.: 949797-100029-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

**Inventor(s): Goldsmith, Edward M., and
DeLap, Christopher K.**

Serial No.: 10/759,525

Filed: January 16, 2004

For: Hockey Stick

Customer No.: 34026

Confirmation No.: 7039

Group Art Unit: 3711

Examiner: Mark S. Graham

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer mailed on September 18, 2007. In Reply, applicant responds to the arguments and grounds advanced in the Answer in support of the Examiner's obviousness rejection.

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I. STATUS OF CLAIMS

Pending Claims & Claims on Appeal:

Claims 30-37, 40, 42-49, and 108-110 are currently pending in the present application, with claim 30 being the sole independent claim. Each of the claims stand rejected under 35 U.S.C. § 103(a). There are no other grounds of rejection. Claims 30-37, 40, 42-49, and 108-110 are on appeal.

Cancelled & Withdrawn Claims:

Claims 1-29, 38-39, and 50-107 were cancelled in Preliminary Amendment dated January 16, 2004. Claim 41, due to typographical error, never existed.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 30-37, 40, 42-49, and 108-110 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Christian (USPNo. 6,039,661) in view of Tiitola (USPNo. 5,407,195).

III. ARGUMENT

The Answer fails to identify any teaching, suggestion or motivation to combine the cited references. Moreover, contrary to the requirements of the Supreme Court in KSR, there is no explicit analysis of apparent reason to combine the elements in the fashion claimed by presented claims. KSR Int'l Co. v. Teleflex, 127 S. Ct. 1727, *1740-41 (April 30, 2007) (To facilitate review, the apparent reason to combine known elements in the fashion claimed by the patent at issue "should be made explicit.") Simply put, the prior art neither teaches, suggests, nor provides motivation to combine the *earlier* Tiitola '195 foam blade (as modified by the Examiner for the obviousness analysis) with the Christian '661 all wood hockey stick. The Examiner's statements for combining the cited references is both conclusory and flawed. The references themselves teach away from the claimed invention, and the logic used by the Examiner is nothing more than an impermissible hindsight.

A. What Christian '661 Discloses (And What It Does Not)

The Christian '661 patent merely discloses a *two (2) piece, all wood hockey replacement blade* additionally having a pair of "reinforcement strips." The wooden blade and wooden shaft are glued together, with the reinforcement members also glued to recessed areas on either side of the shaft (Fig. 6). The entire assembly is then "wrapped" in sheets of fiberglass fabric. (See Col. 6, lines 57-67: "Following this step, the replacement blade can, if desired, be provided with further fabric reinforcement over the exterior surface of the blade 15 and a portion of the shaft 16.") Thus, the blade of Christian '661 is a composite only in the very narrow sense that the "wooden blade stock" and "wooden shaft stock" are glued together and, thereafter, the entire assembly is covered with "wappings of fiberglass" for the stated purpose of reinforcing the assembly. (Col. 6, lines 57-63.) In other words, there is no disclosure, or suggestion, of using a foam core blade anywhere in the reference, and the Examiner has failed to provide an *explicit* reason to do so. All that is offered is conjecture.

Secondly, even though the blade of Tiitola '195 (issued on April 18, 1995) was available prior to the filing date of Christian '661 (filed on August 1997), the Christian '661 patent only discloses and claims the use of a wood core blade.

Elements of the claimed invention (claim 30) not present in Christian '661 include, inter alia, (i) an inner foam core and (ii) a portion of ply fibers being interposed between the recessed heel section surface and the overlying inner surface of the first end-section of the hosel portion.

B. What Tiitola '195 Discloses (And What It Does Not)

In the Response to Argument, the Answer claims that the Tiitola '195 blade structure, even though relying upon "core cavity bridge members" for its structural integrity, would have been modified in such a manner to create a recessed heel area of the blade, so as to allow continuation with the Christian '661 hockey stick. To reach this conclusion the Examiner employs a *non-sequitur*, as follows:

"Obviously if one is to apply the teachings of Tiitola to Christian's blade, this means maintaining the structural integrity of the blade when it is constructed with a recessed heel. Therefore, when the heel of such a foam core blade is recessed in the manner taught by Christian, one of ordinary skill in the art would not simply slice off the fiber reinforced plastic layers to obtain the recess. This approach would clearly leave a structurally useless blade. *To maintain the structural integrity of the blade therefore, it would obviously have been necessary to maintain the fiber reinforced outer layer in the recessed area of the blade.* Thus, in constructing such a blade/shaft connection

in accordance with the teachings of the prior art, one necessarily would have been providing fiber layers "one or more of the recessed heel section surfaces and an overlying inner surface defining the slot" as claimed. (Emphasis added.)

It simply does not follow that in order to "maintain the structural integrity of the [Tiitola] blade" one of ordinary skill would remove the internal structural members within the Tiitola blade and relied solely on the outer layer. Such an assertion is not consistent with the Tiitola reference. Plainly, it is the "core cavity bridge members" that provide structural integrity for the Tiitola blade. In other words, the Examiner suggests, without support, that the outer layer disclosed in Tiitola provides sufficient support for the Tiitola blade, when in fact it is the internal "core cavity bridge members" that provide the necessary support as taught in the patent.

Second, the Tiitola '195 reference *teaches away* from the recessed heel blade configuration proposed by the Examiner. In Tiitola '195, the blade structure is configured *to receive and overlap* the handle portion, as follows:

"With respect to the hockey stick embodiment shown in FIG. 1, the heel end of the final intermediate structure may be configured as shown in FIG. 1 so as to matingly contact with the lower end 3 of the handle section 1. ***Thus the excess reinforcing plastic layers 28 and 29 in this region of the intermediate structure will be extended to overlap the handle portion 3*** so that the entire stick may be placed into a suitably formed mold and the handle immediately formed integral with the blade construct during curing of the blade construct. In FIG. 1, the overlapping portion or region of the fiber reinforced

layers 28 is designated or referred to by the reference numeral 4b. The handle member may be or wood of a composite material, etc." (emphasis added).

(Col. 11, lines 43-56; Fig. 1) Figure 1 in the Tiitola 195 patent plainly shows the handle being received by the "intermediate structure," which also overlaps, or surrounds, the handle section 1. In marked contrast, the present invention, as claimed, has the wooden hosel receiving and overlapping the blade.

Third, the Answer improperly assumes that at the time of the present invention the blade of Tiitola '195 could have been significantly modified to include a recessed heel. Nowhere is this disclosed or suggested in Tiitola '195. In fact, Tiitola '195 teaches the importance of the "bridge members in maintaining the structural integrity of the blade construct," and therefore teaches away from modifying the design (to include a recessed heel) which would necessarily omit or drastically reduce the necessary bridge structures because of a lack of space at the heel (width):

In accordance with the present invention, *the strength of the blade construct will, inter alia, depend on the core cavity bridge members which are integral with the face members* (e.g., glued thereto, formed integral thereto, etc.). The number of bridge members, the blade volume occupied by the core cavity member (e.g., the pocket(s) or hollows as mentioned above), the blade volume of the bridge members, the number of any pockets, etc., may be varied, as desired, in any suitable (known) manner, in accordance with the resin-fiber material and structure desired to be used for the face and bridge members. *However, the configuration and structure of the bridge*

member(s), connecting the face members together, must be such as to adequately maintain the structural integrity of the blade construct in light of the ultimate environment of use of the blade." (Emphasis added.)

It makes no logical sense to modify the Tiitola '195 blade construct in the manner suggested by the Examiner. To do so is to ignore the very teachings of the Tiitola '195 patent and improperly assumes the new blade design would work as intended with the bridge members absent.

C. There Remains No Explicit Reason To Combine The Elements In The Way The New Invention Does

The Answer argues that the Appeal Brief improperly attacks the references individually rather than for what they teach collectively. However, there is no composite paddle portion with a foam core having a recessed heel in *either* cited prior art reference. Nor is there any teaching or suggestion in *either* reference for making the paddle portion in that manner. Further, there is no teaching, suggestion or motivation in *either* reference for a portion of the paddle fibers to be interposed between one or more of the recessed heel section surfaces and an overlying inner surface defining the slot of the hosel portion. As explained above, the cited references teach away from these limitations.

Accordingly, the failure of the Answer to cite to any teaching, or suggestion or motivation in either cited reference, or any reason to combine the claimed elements, amounts to nothing more than impermissible hindsight. As one noted commentator has stated:

"Close adherence to this [Section 103] methodology is especially important ... where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is

used against its teacher. The best defense against the subtle powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirements for a showing of the teaching or motivation to combine prior art references. Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985)."

Robert L. Harmon, Patents and the Federal Circuit § 4.2(b)(ii), p. 158 (Sixth Ed. 2003).


All the Examiner can point to as basis for combining the references is his own conclusory allegation: "[o]bviously if one is to apply the teachings of Tiitola to Christian's blade, this means maintaining the structural integrity of the blade when it is constructed with a recessed heel." Notwithstanding the need for structural integrity, the Examiner goes on to propose removing the very structural elements (i.e. the "core cavity bridge members" of Tiitola) which provide the structural integrity, to wit: "[to] maintain the structural integrity of the blade therefore, it would obviously have been necessary to maintain the fiber reinforced outer layer in the recessed area of the blade." Nowhere in Tiitola '195 is it taught or suggested that the outer layer alone would be sufficient to maintain the structural integrity of the blade.

With regard to whether the Goldsmith Declaration establishes the necessary nexus that the commercial success was predominantly due to the claimed invention, the Answer provides no meaningful argument. The Hybrid Replacement Blade referenced in the Goldsmith Declaration is commensurate with the scope of claim 30, as more fully explained in paragraph 39 thereof.

Respectfully submitted,

JONES DAY

Dated: November 16, 2007

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